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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,807	12/22/2000	Neboisa Jovicic	3252RE	3496

7590 12/29/2003

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EXAMINER

KALINOWSKI, ALEXANDER G

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 12/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/748,807

Applicant(s)

JOVICIC ET AL.

Examiner

Alexander Kalinowski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 12/22/2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-9 is/are allowed.
- 6) ☐ Claim(s) 10-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-15 are presented for examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 10-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Barnett et al., Pat. No. 6,336,099 (hereinafter Barnett).

As to claims 10-11, Barnett discloses A method for selectively transmitting and using redeemable coupons comprising coupon data and data sufficient to identify each coupon , comprising the steps of.

generating coupon offers via a coupon server, the coupon offers comprising coupon indicia and being based on information provided by coupon issuers (col. 6, lines 52-58 and col. 11, lines 24-29) and

consumer computers in electronic communication with the coupon server over an Internet connection providing the coupon server with user indicia including demographic information about the consumers the demographic information being independent of consumer selections of the coupon offers (col. 7, lines 1-5 and line 59 – col. 8, line 1)

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the consumer computers comprising a user database and a browsing memory permitting the consumers to browse coupon offers on a visual display (col. 7, lines 1-5 and col. 8, lines 29-33);

the coupon server making initial coupon offers selectively available to the consumer computers accessing the Internet on the basis of the user indicia at least the initial coupon offers being selectively available to an individual consumer computer based upon the demographic information provided by the individual consumer computer, the coupon server generating new coupon offers different from the initial coupon offers and making them selectively accessible to the consumer computers based upon receipt from the coupon issuers of new coupon information as well as receipt from the consumer computers of the user indicia (col. 8, lines 14-33, col. 12, lines 29-67, col. 13, lines 4-15, lines 30-42; and

making accessible to the consumer computers electronic coupons and permitting the consumers to make on-line selections of redeemable coupon offers (col. 7, lines 1-5)

As to claim 12, Barnett discloses A system for distributing electronic coupons comprising coupon data and data sufficient to uniquely identify each coupon comprising: a network node that can select and receive electronic coupons (unit 6, Fig. 1, and col. 7, lines 1-5);

a coupon server capable of receiving or storing information from the network node (col. 6, lines 58-62)

the coupon server being capable of generating or transmitting electronic coupon information with a serial number sufficient to identify the coupon to the network node

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(i.e. user identification bar code number)(Fig. 3, col. 6, lines 52-65 and col. 7, lines 22-34)

the coupon server being capable of receiving and storing coupon indicia information and receiving coupon information from a coupon notification center, and transmitting coupon generation or redemption information to the coupon notification center (col. 7, lines 51-55)

the coupon notification center having memory for storing coupon generation or redemption information (see unit 16, Fig. 1 and col. 6, lines 58-62) .

As to claims 13 and 15, Barnett discloses A method for distributing electronic coupons (see abstract) comprising

coupon data and data sufficient to identify each coupon comprising the steps of providing registration information to a coupon server via a network node the registration information including demographic information (see Fig. 1 and col. 7, line 62 – col. 8, line 13)

storing the registration information within the coupon server (col. 7, lines 62-67)

the coupon server receiving coupon indicia information from a coupon notification center

storing the coupon indicia information within the coupon server (col. 6, lines 52-57)

generating one or more electronic coupons based on the registration information (col. 8, lines 14-19) each electronic coupon having a serial number and comprising a plurality of digital representations of indicia including the coupon indicia information (i.e. user identification bar code number)(see Fig. 3 and col. 11, lines 1-23)

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the coupon server making the electronic coupons accessible to remote users such that the users can select one of more of the electronic coupons (col. 8, lines 23-33) the coupon server transmitting the coupon generation information to the coupon notification center (see Fig. 1 and col. 6, lines 58-62); and storing the coupon generation information in a database within the coupon notification center(see unit 16, Fig. 1 and col. 6, lines 58-62).

As to claims 14 and 16, Barnett discloses A system for distributing electronic coupons comprising coupon data and data sufficient to uniquely identify each coupon (see Fig. 1 and Fig. 3) comprising a network node that can communicate with a coupon server (Fig. 1) the coupon server being capable of generating electronic coupon information (col. 6, lines 52-54, col. 8, lines 14-19) the coupon server also being capable of communicating at least a portion of the electronic coupon information to the network node (col. 8, lines 14-33) the coupon server also being capable of receiving and storing coupon indicia information (col. 6, lines 52-58) and receiving coupon verification information from a coupon notification center (col. 11, lines 11-29).

Allowable Subject Matter

4. Claims 1-9 are allowed.

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Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Pat. No. 6,321,208 discloses a system for distributing electronic coupons.

b. Pat. No. 5,744,869 discloses a method for providing internet access and sponsor promotion.

c. "Savings in cyberspace" discloses allowing customers to download coupons from the Internet.

d. "'Catalina to take coupons to internet" discloses dispensing coupons from the Internet.

e. "'Coupons go digital" discloses distributing coupons from an Internet Web site.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 9:00 AM to 6:30 PM. In addition, the examiner can be reached on alternate Fridays.

If any attempt to reached the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached on (703) 305-9588. The fax telephone number for this group is (703) 305-7687 (for official communications including After Final communications labeled "Box AF").

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor, receptionist.

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A handwritten signature in black ink, appearing to read "Alexander Kalinowski". The signature is fluid and cursive, with a large, stylized initial 'A'.

Alexander Kalinowski

Primary Examiner

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12/11/03